

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Erickson et al.
Appl. No. : 10/747,639
Filed : December 29, 2003
Title : A METHOD OF MAKING A MOLDED ARTICLE

Grp./A.U. : 1732
Examiner : Edmund H. Lee

Docket No. : 12104

REQUEST FOR RECONSIDERATION

Mail Stop AF
Commissioner of Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Applicants hereby request reconsideration of the finality of the Office Action mailed on August 7, 2007. In particular, the Applicants respectfully assert that the finality of the Office Action is premature due to the citation of an additional reference and the formulation of a new rejection without providing an opportunity to respond. As such, the finality of the office action should be withdrawn to allow the Applicants to adequately respond to the newly cited reference.

MPEP § 706.07(a) provides the guidelines for when a Final Rejection is proper:

Under present practice, second or any subsequent actions on the merits shall be final, **except** where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims . . . Furthermore, a second or any subsequent action on the merits in any application . . . will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), **of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.** [Moreover, a] second or any subsequent action on the merits in any application . . . should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations **which should reasonably have been expected to be claimed.** (Emphasis added)

In the first Office Action, mailed March 22, 2006, the Examiner rejected claims 1, 4, 5, and 9-22 under 35 U.S.C. § 102(b) over Mohiuddin (United States Patent No.

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4,282,285), and further rejected claims 2, 3, 6, and 7 under 35 U.S.C. § 103(a) over Mohiuddin in view of Ramatowski (United States Patent No. 5,256,355). In response to the rejections, the Applicants amended independent claim 1 to more specifically claim the particular base of claim 1 in the form **originally claimed** in claims 23 and 33. As such, **the effect of the amendment to claim 1 was merely to bring claim 1 into alignment with the manner in which the base was claimed in claims 23 and 33, and the amendment did not introduce new subject matter that was not previously claimed.** All other amendments to the claims were made on the same basis. None of the claims were amended in a way that presented subject matter that was not already searched, and therefore **the claim amendments did not necessitate a new search.**

The Examiner has apparently agreed with the Applicant that the prior rejections are overcome in view of the amendments to the claims because the claims are no longer subject to the prior rejections. In the second Office Action dated August 7, 2007, the Examiner applies a new reference (Salem et al., United States Patent No. 2,976,202), and sets forth new rejections under § 103(a) relying on the combination of Mohiuddin and Salem et al. In an attempt to establish the propriety of making the Office Action final, the Examiner has asserted that the Applicants' amendment necessitated the new ground of rejection presented in the Office Action. Again, it is noted that the Applicant merely amended claims to consistently claim the base across all independent claims in a way that was previously claimed. As such, the claims were not amended in a way that necessitated a new search. In accordance with the above, the Applicants respectfully assert that the finality of the second Office Action is premature, improper, and should be withdrawn.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credits to Deposit Account No. 08-2789.

Respectfully submitted

HOWARD & HOWARD ATTORNEYS, P.C.

September 26, 2007

Date

/Christopher S. Andrzejak/

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